

BOARD OF APPEALS DECISIONS

Serial number: 09/289,000

Decision:

~~Affirmed~~

Reversed

Affirmed in Part

Remand

Decision date: September 26, 2003

Examiner: Prebilic
Art Unit: 3738

Initials

date

QAS :

QAS

12/03/03

SPE :

SPM

12/4/03

Examiner :

Comments:

Note pages 9 and 10 of the decision. If this case does not become abandoned, the issues mentioned should be addressed. It is interesting that the board here did address the inherency issue along the lines of MPEP 2112.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 40

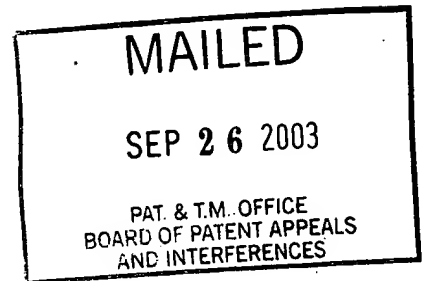
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD BLATT

Appeal No. 2003-1837
Application No. 09/289,000

ON BRIEF



Before GARRIS, OWENS, and POTEATE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-6, 8-10 and 24-31. These are all of the claims remaining in the application.

The subject matter on appeal relates to a method for treating a joint formed by opposing bones having first and second mating joint surfaces so that relative slidable joint motion

between the bones is permanently maintained. The method includes the steps of placing a bioresorbable implant between and in contact with the cancellous bone surface of a first joint and a second joint surface so that the face of the implant is opposite the cancellous bone surface and the implant initially keeps the cancellous bone surface spaced apart from the second joint surface while permitting relative slidable motion between the face and the cancellous bone surface, using the joint while allowing resorption of the implant and causing slidable motions between the face and the cancellous bone surface, and allowing formation of fibroblast at the cancellous bone surface while using the joint so that the fibroblast progresses into fibrocartilage as the implant is resorbed. Further details of this appealed subject matter are set forth in representative independent claims 1 and 8 which read as follows:

1. A method for treating a joint formed by opposing bones having first and second mating joint surfaces so that relative slidable joint motion between the bones is permanently maintained comprising the following steps:

removing at least a portion of the first joint surface to expose a cancellous bone surface;

selecting a bioresorbable implant having a face adapted to face the cancellous bone surface;

placing the bioresorbable implant between and in contact with the second joint surface and the cancellous bone surface so that the face is opposite the cancellous bone surface and the

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implant initially keeps said exposed cancellous bone surface spaced apart from the second joint surface while permitting relative slidable motion between the face and the cancellous bone surface;

using the joint while resorbing the implant and causing slidable motions between the face and the cancellous bone surface; and

forming fibroblast at the cancellous bone surface while using the joint so that the fibroblast progresses into fibrocartilage as the implant is resorbed, the fibrocartilage replaces the implant during such resorption, and thereafter relative slidable motion between the bones along the fibrocartilage occurs when using the joint.

8. A method for treating a substantially non-weight bearing arthritic joint having first and second mating joint surfaces so that relative slidable joint motion between the bones is permanently maintained comprising the following steps:

removing at least a portion of the first and second joint surfaces to expose first and second cancellous bone surfaces;

selecting a bioresorbable implant having first and second implant faces corresponding to the first and second cancellous bone surfaces;

placing the first and second implant faces of the bioresorbable implant between and against the first and second exposed cancellous bone surfaces so as to permit relative slidable motion between the first and second faces and the first and second cancellous surfaces;

using the joint and causing slidable motions between the face and the first cancellous surfaces; and

while using the joint forming fibrocartilage at each said cancellous bone surface as the implant is resorbed to thereby replace the implant during such resorption and enable slidable motion between the bones along the formed fibrocartilage.

The references set forth below are relied upon by the examiner in the section 102 and section 103 rejections before us:

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Delcommune et al. (Delcommune)	5,007,939	Apr. 16, 1991
Cohen	5,207,712	May 4, 1993

Claims 1, 4-6, 8-10 and 24-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by or alternatively under 35 U.S.C. § 103(a) as being obvious over Cohen; and claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being obvious over Cohen in view of Delcommune.¹

We refer to the brief and reply brief and to the answer for a complete exposition of the differing viewpoints expressed by the appellant and by the examiner concerning these rejections.

OPINION

For the reasons set forth in the answer and below, we will sustain each of these rejections.

It is the examiner's basic position that the method of Cohen's Figure 10 embodiment would necessarily and inherently practice each of the here claimed method steps including the step of causing slidable motions between the implant face and the cancellous bone surface. As support for his position concerning

¹ On page 5 of the brief, the appellant states that "[a]ll claims stand or fall together." In addition, the appellant has proffered no separate arguments concerning the separate rejection of dependent claims 2 and 3. Therefore, in assessing the merits of the above noted rejections, we will focus on independent claim 1 as representing the claims on appeal. See 37 CFR § 1.192(c)(7)(8)(2002) and compare In re McDaniel, 293 F.3d 1379, 1382-83, 63 USPQ2d 1462, 1464-65 (Fed. Cir. 2002).

this last mentioned claim feature, the examiner refers to patentee's teaching that, "[a]fter placement [of the implant], the stability and position of the toe is checked" and that "[f]lexion and extension of the joint should not result in dislocation of the implant" (column 4, lines 37-39). On the other hand, it is the appellant's fundamental argument that, not only does the Cohen reference contain no teaching or suggestion regarding this slidable motion feature, but that the configuration and placement of patentee's Figure 10 implant are such that slidable motion between the implant face and the cancellous bone surface as required by each of the independent claims on appeal would be impossible. Moreover, as support for this argument, the appellant on pages 10-13 of the brief refers to the Blatt and Smith declarations of record.

In response to this argument, the examiner reiterates his position regarding the aforequoted flexion disclosure of Cohen and emphasizes that, "since the fit of the holes [i.e., in the bone] and rod o[r] shaft of Cohen are [sic, is] not tight . . . , the Examiner posits that at least some slight motion is possible to the extent required by the present claim language" (answer, page 6). The appellant rebuts the examiner's last mentioned point by contending that "[t]he Cohen patent nowhere states that

a tight fit between the holes and implant shafts is not required" (reply brief, page 2). This contention by the appellant clearly is without merit. At lines 33-35 in column 4, patentee explicitly teaches that "a tight fit between holes and implant shafts is not required." Further, we perceive well taken rationale in the examiner's position that, in the absence of a tight fit between holes and implant shafts, at least some degree of slidable motion between the face (i.e., sphere 72) of patentee's Figure 10 implant and the cancellous bone surface would be possible. As properly indicated in the answer, even a slight degree of slidable motion would satisfy the claim requirement under consideration. Finally, it is significant that the aforementioned Blatt and Smith declarations do not address this specific aspect of the Cohen disclosure.

In light of the foregoing, it is our determination that the examiner has established a reasonable basis for believing that Cohen's method would necessarily and inherently practice the slidable motion step required by the independent claims on appeal notwithstanding a full consideration of the appellant's position to the contrary. Under these circumstances, it is appropriate that the appellant be required to prove that the Figure 10 embodiment of patentee's method, in the absence of a tight fit

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between holes and implant shafts as discussed above, would not actually practice the here claimed slidable motion feature. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain prior art products in order to thereby compare Cohen's aforementioned method with the here claimed method. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). On the record before us, the appellant has submitted no proof that the practice of Cohen's method in the absence of a tight fit between holes and implant shafts would fail to result in slidable motion as required by the independent claims on appeal.

Consequently, it is our ultimate determination that the examiner has established a prima facie case of unpatentability which the appellant has not successfully rebutted with argument and/or evidence of patentability. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We shall sustain, therefore, the examiner's section 102 and section 103 rejections of claims 1, 4-6, 8-10 and 24-31 based on the Cohen reference. The section 103 rejection of claims 2 and 3 based on

Cohen in view of Delcommune also will be sustained since the appellant has not separately contested this rejection on the record before us.

Other Issues

The method defined by appealed independent claim 8 and by the claims which depend therefrom requires placing first and second implant faces of a bioresorbable implant between and against first and second exposed cancellous bone surfaces "so as to permit relative slidable motion between the first and second faces and the first and second cancellous surfaces" (claim 8). However, our study of the appellant's specification and drawing raises the issue of whether one with an ordinary level of skill in this art would be able to practice the claim 8 requirement "so as to permit relative slidable motion between the first and second faces and the first and second cancellous surfaces" (i.e., as required by the first paragraph of 35 U.S.C. § 112).

With reference to Figures 2 and 3 of the appellant's drawing and the specification disclosure relating thereto, the implant 23 is "mounted to resected head 14 of the humerus with . . . stem 26 of implant 23 locking into cavity 21 formed in the medullary canal of the humerus" (specification, page 7, lines 28-32; emphasis added). While this arrangement would permit slidable

motion between the implant face at head 24 and the cancellous surface 34 of socket 30, it is clear that slidable motion would not be permitted between the other implant face (i.e., the flat portion beneath head 24) and the cancellous surface 20 of head 14. That is, the implant face beneath head 24 would not be capable of slidable motion relative to cancellous surface 20 because, according to the appellant's aforequoted disclosure, implant 23 is mounted to head 14 by way of stem 26 locking into cavity 21.

Under these circumstances, it appears that the method and implant described in the appellant's original disclosure would not be capable of practicing the claim 8 method requirement "so as to permit relative slidable motion between the first and second faces and the first and second cancellous surfaces." In essence, the implant face which is adjacent cancellous surface 20 would not be capable of slidable motion relative to this surface for reasons analogous to those advanced by the appellant with respect to the Figure 10 implant of Cohen. While the appellant's reasoning is unpersuasive with respect to the Cohen implant as

explained above, this reasoning is applicable and convincing with respect to the implant disclosed in the subject specification.²

In addition to the enablement issue mentioned previously, these circumstances raise the issue of whether the subject matter now claimed by the appellant in claim 8 and the claims which depend therefrom complies with the written description requirement set forth in the first paragraph of 35 U.S.C. § 112. These circumstances may raise yet a further issue under the second paragraph of section 112 since the requirements thereof demand that a claim must accurately define an applicant's invention. See In re Knowlton, 481 F.2d 1357, 1365-66, 178 USPQ 486, 492 (CCPA 1973).³

These issues should be addressed by the examiner and the appellant in any further prosecution that may occur.

Summary

The decision of the examiner is affirmed.


² It is here appropriate to emphasize that the appellant's disclosure expressly describes the implant as being mounted and locked into bone cavity 21 whereas, in opposing contrast, Cohen's disclosure expressly teaches "a tight fit between holes and implant shafts is not required" (column 4, lines 33-35).

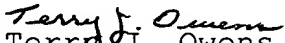
³ A section 112, second paragraph, issue also may be raised by dependent claim 9 since the phrase "the first implant surface" lacks antecedent basis (e.g., see In re Altenpohl, 500 F.2d 1151, 1156-57, 183 USPQ 38, 43 (CCPA 1974)). Apparently, this phrase should read --the first implant face--.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


Bradley R. Garris
Administrative Patent Judge


Terry J. Owens
Administrative Patent Judge


Linda R. Poteate
Administrative Patent Judge

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